

## **R E M A R K S**

The office action of March 7, 2007 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 18 remain in this case.

## **DETAILED ACTION**

Prosecution has been re-opened in response to the Appeal Brief filed on 11/20/2006. Accordingly, the following is a Non-Final Office Action. Claims 1-18 are pending in this application.

### ***Claim Rejections under 35 USC § 101***

Claims 1-11 have been rejected under 35 U.S.C. 101 on the grounds that the claimed invention is allegedly directed to non-statutory subject matter. The Examiner asserts that claim 1 is a method claim that recites people as part of that method. Claims 2-11 depend from claim 1 and therefore contain the same alleged deficiencies.

Applicants respectfully traverse this ground of rejection. The coordinator is not a person. On

page 5, lines 1-2 it states that, “the coordinator creates a separate page within *its* web site...[emphasis added]”. Figure 2 shows an exemplary stencil produced by the coordinator for a specific shipper. The stencil refers to “gotpallets.com” [22] and shows a phone number for the “coordinator” [21]. Figure 3 is an example of a web page created by the coordinator, which references Ongweoweh Corp. as controlling the web page. Figure 4 clearly states that “gotpallets.com” is a service of Ongweoweh Corp. Therefore, it should be readily apparent that the “coordinator” is Ongweoweh Corp., the assignee of this application via an assignment signed by Applicants and dated Oct. 30, 2001. Ongweoweh is a corporate entity and is identified as the coordinator of the method claimed in this application. The withdrawal of this rejection is therefore respectfully requested.

### ***Claim Rejections - 35 USC § 112***

Claims 1-11 and claims 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that , “Claim 1 recites ‘a method for retrieving shipping platforms which have been sent by a plurality of original shippers to a plurality of end recipients through a coordinator for reuse’. However, in the body of claim 1, it appears that the end recipient is placing the shipping platforms for sale on a computer site, without the original shipper's consent (i.e. the original shipper must be notified of the posting for sale). Therefore, it is unclear as to how the preamble of the claim specifically matches the body of the claims.”

The preamble of claim 1 describes a “method for retrieving specifically identified shipping platforms” that have *already* been sent through normal commerce to a plurality of end recipients. The original shippers do not send their products, including shipping platforms, through the coordinator’s web site. Only once the end recipient accumulates a number of “specifically identified shipping pallets”, does the end recipient contact the coordinator to initiate the process of arranging for the return of those specific pallets to the original shipper through the process set up by the coordinator company.

The Examiner further states that it is “unclear who has ownership of the shipping platforms and what the relationship is between the parties of the method. It is specifically unclear as to whether the claim is directed to a method for retrieving platforms by an original shipper owning the platforms using a third-party manger or to a method for selling used shipping platforms, wherein the original shipper is merely a buyer using the coordinator's venue.”

The platforms of the original shipper are marked with symbols identifying both the original shipper and the coordinator. The Applicants’ method is not a third party resale system. The original shipper is not even aware of the existence of any of their original “specifically identified” shipping platforms for sale until the coordinator is notified by the end recipient of the existence of those platforms. The coordinator then notifies the original shipper at this time. Only if the original shipper wants to purchase back its original platforms does the coordinator facilitate the transaction. As to ownership, once the shipping platforms have been shipped by the original shipper with the shipper’s primary goods, the shipping platforms no longer are the property of the original shipper. Should the coordinator become aware of specifically identified platforms that had been shipped by the original shipper and that the current owner of these platforms, the end recipient, is willing to sell them to the original shipper for a negotiated price,

does the coordinator assist in bringing together the original shipper with the end recipient, through the claimed method, for the purpose of enabling the original shipper buy back its original shipping platforms.

It appears that there is confusion with regard to the use of the word “type” in the claims. Therefore, this term has been omitted from the claims and replaced with a more accurate identifier “specifically identified” or “specific identification” (support for which may be found on page 6, lines 16-17 of the specification, as filed).

With regard to the objections raised pertaining to claims 4, 6 and 14, it is respectfully submitted that the foregoing discussion and amendments to the claims should now render them moot. Accordingly, Applicants respectfully request the withdrawal of these grounds of rejection.

#### ***Allowable Subject Matter***

The Examiner finds that claims 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Applicants gratefully acknowledge the Examiner’s identification of allowable subject matter. However, they respectfully submit that with the foregoing amendments to the claims and the accompanying arguments, the cited art allows a broader scope of allowable subject matter.

***Claim Rejections - 35 USC § 103***

Claims 1-3 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meehan et al. (U.S.2002/0029187) in view of Chep. Without conceding the propriety of the asserted combination, Applicants respectfully submit that the asserted combination does not disclose at least the principal elements of claim 1. CHEP.com consists of a group of *member* companies who ship and retrieve containers within a *closed loop* business environment. **CHEP retains ownership** of their shipping platforms throughout the entire process of transfer from the original shipper to the end recipient and back to the original shipper again. They mark their platforms as being the property of CHEP. Meehan et al. discloses a system for buying and selling goods and services over the internet. The system entertains many purchasers of a single item and permits bidding for this item, much like on-line auction sites such as eBay. This teaches away from Applicants' method, which focuses on reconnecting specifically identified shipping platforms in the hands of end recipients with their original shipper through the method of claim 1. The combination of CHEP with Meehan et al. fails to achieve a system for reconnecting items that have reached the end of their commercial journey, such as shipping platforms, with the original shippers of those items. Claim 1 describes a method whereby a plurality of independent original shippers can re-purchase their own shipping platforms through a website established and managed by a third party, the coordinator. The coordinator assigns an identification to each platform that is specific to the original shipper (Claim 1-a), associates the specific platforms with the original shipper via an internet file (Claim 1-b) and contacts the

appropriate original shipper when *its own original* platforms have been listed on the coordinator's website (Claim 1-c) by an end recipient of the specifically identified shipping platforms. The web site is a limited forum where only the coordinator and the end recipient have access. Only upon receipt of information about the existence of specifically identified shipping platforms from an end recipient does the coordinator then contact the identified original shipper to facilitate the process of selling the shipping platforms from the end recipient to the original shipper of those specifically identified shipping platforms that were sent into the stream of commerce by the original shipper when it shipped its core product sometime in the past. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

Claims 12-13 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chep in view of Berstis (U.S. 2002/0082974). The elements of CHEP have been discussed hereinabove and are incorporated herein by reference. Berstis is an auction or "want add" web site that allows a user to store in a profile an identification of a specific item needed by the user, including the quantity of items desired. The user is notified when another user offers that item for sale. The potential buyer and seller quote prices for the items that each would be willing to pay or receive, respectively. If the parties fail to come to acceptable terms, then the "bidding" is opened to other potential buyers/sellers (page 3, paragraphs [0030] and [0031]). Without conceding the propriety of the asserted combination, Applicants respectfully submit that the asserted combination fails to achieve Applicants' method of reconnecting items that have reached the end of their commercial journey, such as *specifically identified* shipping platforms, with the original shippers of those *specific* items, namely the shipping platforms.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meehan et al. (U.S. 2002/0029187) in view of Chep.com (as set forth above) and in further view of Mori et al. (U.S. 6,044,363).

The Examiner correctly notes that neither Meehan et al. nor Chep.com disclose coordinating a shipment of goods, such as the shipping platforms, from an end recipient to the original shipper of such goods. Applicants respectfully point out that Mori et al. adds nothing to the combination of Meehan et al. and Chep.com which would remedy the deficiency of the combination of the first two citations.

Mori et al. discloses an auction system. The essence of this citation is that the auction system is “automatic” in that the bidders set up parameter with which they are willing to accept and the “system” then conducts the auction without the need for their presence on line. It is respectfully submitted that one of ordinary skill in the art of locating and retrieving shipping platforms would not have been motivated to look to on-line auction programs of either Meehan et al. or Mori et al. to achieve their goal. Accordingly, favorable reconsideration and withdrawal of this rejection is respectfully requested.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meehan et al. in view of Chep (as set forth above) and in further view of Canadian Pallet Council (CPC) (www.cpcpallet.com). The references used to disclose the aspects of Chep.com and Tradeout.com [sic: presumably meant to be “Meehan et al.”] are set forth above.

As per claims 7-9, neither Meehan et al. or Chep.com expressly disclose repair standards associated for listed items. CPC discloses a system that maintains a pool of standardized pallets that are owned by members of CPC. Much like CHEP, this is a closed

loop business network. Members add and remove pallets from the pool while CPC tracks the balance of each member's inventory. In effect, *CPC are inventory control managers*. If one were to combine the teachings of CPC with the systems of Meehan et al. and CHEP, it would create an internet auction site where only members of CPC could bid on pallets listed by other members. Creating such a system is counterintuitive since it would enable *third parties* to purchase pallets *already owned by another company*. This is inconsistent with the business model of CHEP since CHEP retains ownership of its own pallets, regardless of the location of those pallets. Applicants respectfully submit that merely because CPC references repair standards adds nothing to Chep.com and Meehan et al. that would remedy the deficiency of the combination of the primary citations. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chep (as set forth above) in view of Berstis (U.S. 2002/0082974) and in further view of Canadian Pallet Council (CPC) (cpcpallet.com). Without conceding the propriety of the asserted combination, Applicants respectfully submit that this combination does not disclose at least that a coordinator assists an original shipper in providing a specific identifier for its shipping platforms, which it then sends off into the stream of commerce, and the coordinator setting up a web site (referenced by the specific identification on the shipping platform) to enable an end recipient of the *specifically identified* shipping platforms to sell these shipping platforms back to the original shipper. The fact that Chep.com discloses repair standards adds nothing to remedy the fundamental deficiency of the combination of Berstis and CPC. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.



### **Conclusion**

Applicants believe that the claims, as amended, are patentable over the referenced citations, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, she is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

--Richards et al.--

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